

**REMARKS**

The United States Patent and Trademark Office (the “Office”) restricted this application to either of Group I claims, Group II claims, or Group III claims. The Applicants elected claims 1-17 during a telephone interview. The Office has since rejected claims 1, 4-11, and 14-17 under 35 U.S.C. § 102 (b) as being anticipated by U.S. Patent 5,884,202 to Arjomand. Claim 2 was rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Arjomand* in view of U.S. Patent 6,362,720 to Razavi *et al.* Claim 12 was rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Arjomand* in view of “official notice.” Claims 3 and 13 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Arjomand* in view of U.S. Patent 6,351,221 to Phillips *et al.* The Applicants show, however, that claims 1, 4-11, and 14-17 are not anticipated, and that claims 2, 3, 12, and 13 are not obvious. The Applicants, then, respectfully submit that the pending claims 1-17 are ready for allowance.

**Rejection of Claims Under 35 U.S.C. § 102**

The Office rejected claims 1, 4-11, and 14-17 under 35 U.S.C. § 102 (b) as being anticipated by U.S. Patent 5,884,202 to Arjomand. A claim is anticipated only if each and every element is found in a single prior art reference. *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q. 2d (BNA) 1051, 1053 (Fed. Cir. 1987). *See also* DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2131 (orig. 8<sup>th</sup> Edition) (hereinafter “M.P.E.P.”). As the Applicants show, however, claims 1, 4-11, and 14-17 are patentably distinguishable over *Arjomand*. The reference to *Arjomand* does not anticipate claims 1, 4-11, and 14-17, and the Applicants respectfully request allowance of these claims.

1) **Independent Claim 1 is NOT Anticipated**

Independent claim 1 is not anticipated by the patent to *Arjomand*. Claim 1 requires that a wireless communication is initiated in response to the diagnostic message. That is, when the diagnostic message is detected, the method responds by initiating a wireless communication.

*Arjomand* makes no such teaching. Examiner Nguyen is correct — *Arjomand* teaches a system that wirelessly communicates diagnostic information between the vehicle and the components of the system. *Arjomand*, however, does not initiate this wireless communication in response to any diagnostic message. As *Arjomand* repeatedly explains, a user of *Arjomand's* system must issue a command to wirelessly communicate diagnostic information. As *Arjomand* states, the “user operates the combined user interface and main control module 12 to control the system” (column 9, lines 39-41). The “wireless networked modules also include at least one remotely operated instrumentation module to perform various measurements and/or provide data under command of the user interface and main control module” (column 3, lines 28-31) (emphasis added). “[T]he user interface module commands the remotely operated main control module to execute diagnostic routine … by wireless communication” (column 3, lines 33-37) (emphasis added). “The unique attribute of this embodiment of the invention is that the combined user interface and main control module is provided with an interactive display that commands the remotely operated instrumentation modules over a wireless communication link” (column 3, lines 59-65) (emphasis added). “The user interface module communicates with a separate *remotely operated* main control module by wireless communication” (column 4, lines 2-4) (emphasis added). The “user interface and main control module 12 provides information to the user and receives commands from the user to process or communicate to the VCI instrumentation module 14 and/or the DVOM instrumentation module 16 by wireless communication” (column 5, lines 48-54) (emphasis added). “The user interface and main control module 12 executes diagnostic application programs and commands the VCI instrumentation module 14 to provide status information and exercise various systems of the motor vehicle and also commands the DVOM instrumentation module to perform measurements and provide measurement data” (column 9, lines 51-57) (emphasis added).

*Arjomand* further describes how the components of the system are *remotely operated*. “The user interface module communicates with a separate remotely operated main control module by wireless communication” (column 4, lines 2-4) (emphasis added). “As shown in FIG. 7, the system 10 further comprises an additional remotely operated instrumentation

module” (column 9, lines 66-67) (emphasis added). “The interface module 46 enables the engine analyzer 48 to be incorporated into the system 10 for *remote operation by the combined user interface and main control module 12*” (column 10, lines 11-13) (emphasis added). “The system 10 comprises at least one separate user interface module 52, the separate *remotely operated* main control module 54, and at least one *remotely operated* instrumentation module” (column 10, lines 37-39) (emphasis added). “The system 10 is a multi-box platform configuration comprising the separate user interface module(s) 52 *operated remotely* from a main control module 54” (column 10, lines 43-45) (emphasis added). **Because Arjomand's main control module is remotely operated by the user interface module, Arjomand must issue a command to wirelessly communicate diagnostic information.** *Arjomand*, then, does not initiate this wireless communication in response to any diagnostic message.

*Arjomand* cannot anticipate claim 1 of this application. Claim 1 requires that a wireless communication is initiated in response to the diagnostic message. *Arjomand*, however, does not initiate this wireless communication in response to any diagnostic message. *Arjomand*, in contradistinction, requires that a user issue commands to wirelessly communicate diagnostic information. Because *Arjomand's* system does not “initiat[e] a wireless communication in response to the diagnostic message,” *Arjomand* cannot anticipate claim independent claim 1 of this invention. The Applicants, then, respectfully ask Examiner Nguyen to remove the § 102 rejection and to allow independent claim 1.

2) **Independent Claim 11 is NOT Anticipated**

Independent claim 11 is also not anticipated by the patent to *Arjomand*. Claim 11 incorporates the same patentably distinguishing steps as claim 1. *Arjomand*, as explained above, does not initiate this wireless communication in response to any diagnostic message. *Arjomand*, instead, requires a user to issue a command to wirelessly communicate diagnostic information. *Arjomand*, then, cannot anticipate claim independent claim 11 of this invention. The Applicants, then, respectfully ask Examiner Nguyen to remove the § 102 rejection and to allow independent claim 11.

*Arjomand* also fails to teach any “request.” Claim 11, in addition, requires that a “request” is made to initiate a wireless communication in response to the diagnostic message. *Arjomand*, again, makes no such teaching. *Arjomand* wholly fails to even mention any type of “request.” Furthermore, because *Arjomand* requires a user to issue commands to wirelessly communicate diagnostic information, *Arjomand* inherently does not teach any “request” to initiate a wireless communication. The office action refers to FIG. 1, FIG. 8, and column 3, lines 22-46 as teaching a “request.” This is incorrect — Applicants have already shown that column 3, lines 22-46 (and lines 59-65!) require a “command” to wirelessly communicate information. *Arjomand*, then, cannot anticipate claim independent claim 11 of this invention. The Applicants respectfully ask Examiner Nguyen to remove the § 102 rejection and to allow independent claim 11.

**3) Dependent Claims 4-10 are NOT Anticipated**

Dependent claims 4-10 are not anticipated by the patent to *Arjomand*. Claims 4-10 depend from independent claim 1, and thus these claims incorporate the same patentably distinguishing steps. Because *Arjomand* cannot anticipate independent claim 1, all the dependent claims thereunder are likewise not anticipated. The Applicants, then, respectfully ask Examiner Nguyen to remove the § 102 rejection of dependent claims 4-10.

**4) Dependent Claims 14-17 are NOT Anticipated**

Dependent claims 14-17 are not anticipated by the patent to *Arjomand*. Claims 14-17 depend from independent claim 11, and thus these claims incorporate the same patentably distinguishing steps. Because *Arjomand* cannot anticipate independent claim 11, all the dependent claims thereunder are likewise not anticipated. The Applicants, then, respectfully ask Examiner Nguyen to remove the § 102 rejection of dependent claims 14-17.

**Rejection of Claims Under 35 U.S.C. § 103**

Claim 2 was rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Arjomand* in view of U.S. Patent 6,362,720 to Razavi *et al.* Claim 12 was rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Arjomand* in view of “official notice.” Claims 3 and 13 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Arjomand* in view of U.S. Patent 6,351,221 to Phillips *et al.* If the Office wishes to establish a *prima facia* case of obviousness, three criteria must be met: 1) combining prior art requires “some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill”; 2) there must be a reasonable expectation of success; and 3) all the claimed limitations must be taught or suggested by the prior art. DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8<sup>th</sup> Edition) (hereinafter “M.P.E.P.”). As the Assignee shows, however, dependent claims 2, 3, 12, and 13 are not obvious in light of any combination of *Arjomand*, *Razavi*, *Phillips*, and/or “official notice.” The Applicants, then, respectfully request allowance of these claims.

#### **1. The Prior Art Does Not “Teach or Suggest” The Limitations of Claims 2**

Claim 2 is not obvious. Claim 2 depends from independent claim 1 and thus incorporates the same patent features. The proposed combination of *Arjomand* and *Razavi* still fails to teach “initiating a wireless communication in response to the diagnostic message.” Examiner Nguyen is correct — *Razavi* teaches a “global positioning system (GPS) receiver … coupled to in-car sub-network 20 for providing automobile location information” (U.S. Patent 6,362,720 to Razavi *et al.*, column 6, lines 60-62). The proposed combination of *Arjomand* and *Razavi*, however, does not “initiat[e] a wireless communication in response to a diagnostic message.” The proposed combination of *Arjomand* and *Razavi*, as explained above, still requires that a user issue commands to wirelessly communicate diagnostic information with a vehicle’s location. Thus, one of ordinary skill in the art would not have thought it obvious to combine and/or modify *Arjomand* and *Razavi* to obviate claim 2. The prior art does not “teach or suggest” the limitations of claim 2, so any *prima facia* case must fail. The applicants, then, respectfully ask Examiner Nguyen to remove the § 103 rejection of claim 2.

## 2. The Prior Art Does Not “Teach or Suggest” The Limitations of Claim 12

Claim 12 is not obvious. The proposed combination of *Arjomand* and *Razavi*, as described above, fails to teach “initiating a wireless communication in response to the diagnostic message.” The proposed combination of *Arjomand* and *Razavi* also fails to teach any request to an occupant of the vehicle to initiate wireless communication in response to the diagnostic message. Neither *Arjomand* nor *Razavi*, in fact, mentions any type of “request” procedure to initiate wireless communication in response to the diagnostic message. The proposed combination of *Arjomand* and *Razavi*, as explained above, requires that a user issue commands to wirelessly communicate diagnostic information with a vehicle’s location. Thus, one of ordinary skill in the art would not have thought it obvious to combine and/or modify *Arjomand* and *Razavi* to obviate claim 12. The prior art does not “teach or suggest” the limitations of claim 12, so any *prima facia* case must fail. The applicants, then, respectfully ask Examiner Nguyen to remove the § 103 rejection of claim 12.

The applicants strongly disagree with the assertion of “official notice.” The office action states that the language of claim 12 merely “gives an option” and is thus “old and well known.” The office action compares claim 12 to voice-mail messages and cell phones. This comparison is erroneous. Heretofore the occupant of a vehicle has never been requested to initiate the wireless communication in response to the diagnostic message. Heretofore the occupant merely receives a “check engine,” “maintenance required,” “service soon,” or similar warning light. Never has the occupant been requested to initiate wireless communication in response to the diagnostic message. Even the patent to *Razavi* explains that owners of automobiles are not permitted to access nor interact with on-board diagnostic systems. As *Ravazi* states, the “owner of the automobile may be allowed to access substantially all of the components and functions of the in-car sub-network *except for detailed vehicle diagnostic information* (U.S. Patent 6,362,730 to *Ravazi et al.* at column 7, lines 34-37) (emphasis added). The on-board diagnostic (OBD) systems are of a “*proprietary design which was not originally intended to be connected to a network*” (*Ravazi* at column 7, line 65-column 8, line 1) (emphasis added). Claim 12, then,

cannot be “old and well-known” when occupants have heretofore never been requested to initiate the wireless communication in response to the diagnostic message. Thus, one of ordinary skill in the art would not have thought it obvious to combine and/or modify *Arjomand* and *Razavi* to obviate claim 12. The *prima facia* case must fail, so the applicants respectfully ask Examiner Nguyen to remove the § 103 rejection of claim 12.

**3. The Prior Art Does Not “Teach or Suggest” The Limitations of Claims 3 & 13**

Claims 3 and 13 are not obvious. Claim 3 depends from independent claim 1, and claim 13 depends from independent claim 11. Claims 3 and 13, then, incorporate the same patent features. The proposed combination of *Arjomand* and *Phillips*, therefore, still fails to teach “initiating a wireless communication in response to the diagnostic message.” The proposed combination of *Arjomand* and *Phillips*, as explained above, still requires that a user issue commands to wirelessly communicate diagnostic information. Thus, one of ordinary skill in the art would not have thought it obvious to combine and/or modify *Arjomand* and *Phillips* to obviate claims 3 and 13. The prior art does not “teach or suggest” the limitations of claims 3 and 13, so any *prima facia* case must fail. The applicants, then, respectfully ask Examiner Nguyen to remove the § 103 rejection of claims 3 and 13.

**Change Of Correspondence Address**

Examiner Nguyen, please note a formal Change of Correspondence is submitted with this response. The correct correspondence address is Scott P. Zimmerman PLLC, P.O. Box 3822, Cary NC 27519. The phone number is (919) 387-6907, and the fax is (919) 387-6959.

---

If any issues remain outstanding, the Office is requested to contact the undersigned at (919) 387-6907 or [scott@scottzimmerman.com](mailto:scott@scottzimmerman.com).

U.S. Application No. 09/776,188 Examiner NGUYEN, Art Unit 3625  
Response to First Office Action

Respectfully submitted,

Scott P. Zimmerman

Reg. No. 41,390